

**REMARKS/ARGUMENTS**

Upon entry of the above amendment, claims 35, 37, 40, 44, 45, and 46 will have been amended, and new claims 47-48 will have been submitted for consideration by the Examiner. Thus, claims 35-48 still remain pending. In view of the above, Applicant respectfully requests reconsideration of the outstanding objection and rejections of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided.

Turning to the merits of the action, the Examiner has rejected claim 41 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner pointed out that the limitations of “wherein the predetermined character comprises a pause” contains subject matter which was not described in the specification.

In response, Applicant notes that at least page 10, lines 3-12 describes the pause key 38 with respect to features of claim 41. Thus, Applicant respectfully requests that the Examiner withdraw the rejection of claim 41.

The Examiner has rejected claim 41 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly the subject matter which Applicant regards as the invention. In this regard, the Examiner points out that it is unclear what number (from 0-infinity) is the pause number. By the present amendment, Applicant has amended independent claim 40 to clarify the scope of

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dependent claim 41. Thus, Applicant respectfully requests that the Examiner withdraw the rejection of claim 41.

The Examiner has rejected claims 35-46 under 35 U.S.C § 102(b), as being anticipated by MATSUNAI (U.S. Patent No. 5,357,350).

As noted above, Applicant has amended claims 35, 37, 40, 44, 45, and 46 for consideration by the Examiner. Applicant respectfully traverses the above rejection based on pending claims 35-46 and will discuss said rejection with respect to the pending claims in the present application as will be set forth herein below. The newly added claims merely clarify the subject matter recited in the canceled claims, but do not narrow the scope of the claims.

Applicant's claims 35 and 36 relate to an image recording apparatus which has a copy mode and a facsimile mode. The image recording apparatus comprises a panel section which has input keys operable to input a numerical value corresponding to at least one of a number of copies in the copy mode and a telephone number of a destination in the facsimile mode. The image recording apparatus includes a display section which selectively displays one of a screen for the copy mode and a screen for the facsimile mode. A display capacity of the screen in the copy mode is smaller than a display capacity of the screen in the facsimile mode. The image recording apparatus further has a controller which, when the copy mode is set and when the numerical value input by the panel section exceeds the display capacity of the screen in the copy mode, switches from the copy mode to the facsimile mode. Claim 44 recites a related method.

Applicant's claims 37-39 relate to an image recording apparatus which has a copy mode and a facsimile mode. The image recording apparatus comprises a panel

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section which has an input key operable to input a numerical value corresponding to one of a number of copies in the copy mode and a telephone number of a destination in the facsimile mode, and which has a start key which starts one of copying and facsimile transmission. The image recording apparatus also comprises a controller which determines whether or not a numerical value input by the panel section is a numerical value corresponding to the number of copies when the copy mode is set, and which, when the numerical value input by the panel section is not the numerical value corresponding to the number of copies and when the start key is actuated, maintains the copy mode and inhibits copying. Further, the controller waits for another input by the panel section in the copy mode when the controller inhibits copying. Claim 45 recites a related method.

Applicant's claims 40-43 relate an image recording apparatus which has a copy mode and a facsimile mode. The image recording apparatus comprises a panel section which has an input key operable to input a numerical value corresponding to one of a number of copies in the copy mode and a telephone number of a destination in the facsimile mode. The image recording apparatus also comprises a controller which determines, when the copy mode is set, whether or not an input by the panel section includes a predetermined character, and which switches from the copy mode to the facsimile mode when the input by the panel section includes the predetermined character. The predetermined character does not including a numerical value. Claim 46 recites a related method.

On the contrary, MATSUNAI relates to an image forming apparatus which inputs a numeric value, sets the numeric value as the number of copies of a copy mode, and

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sets the numeric value as a number for specifying a destination of a facsimile mode. The image forming apparatus detects the number of figures (i.e. digits in the numeric), and performs one of the copy mode and the facsimile mode in accordance with the detected number of figures (i.e. digits in the numeric). According to Fig. 4, MATSUNAI checks whether the number of inputs by the keys 18b reaches numeric limit (STP6). When the number of inputs by the keys 18b reaches the numeric limit (5), the copy mode is switched into the facsimile mode (STP7).

However, when the number of inputs by the keys 18b is 4 (i.e., less than the numeric limit (5) and more than the display capacity (3) of the display section 18e), the copy mode is not switched into the facsimile mode. In other words, the numeric limit (5) does not correspond to the display capacity (3) of the display section 18e in the copy mode, but rather corresponds to "numeric data, e.g., 5 which is difficult to be regarded as the number of copies or a magnification" (col. 6, lines 65-66). In this regard, Applicant notes that MATSUNAI shows a plurality of display areas, all labeled 18e which each display a single data (magnification, facsimile number and copies) but does not disclosed selective display as recited.

Thus, MATSUNAI does not disclose the controller which, when the copy mode is set and *when the numerical value input by the panel section exceeds the display capacity of the screen in the copy mode*, switches from the copy mode to the facsimile mode. Rather, MATSUNAI switches when a number of digits input reaches a limit value (e.g.,5).

With respect the Applicant's above-noted argument, the Examiner replies that col. 5, lines 2-20 clearly teaches display of a copy number, magnification number which

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is limited to 5, as disclosed in Fig. 5, STP 24. Applicant agrees with the Examiner that display section 18e displays a copy number and magnification number. However, MATSUNAI does not teach a controller which, when the copy mode is set and *when the numerical value input by the panel section exceeds the display capacity of the screen in the copy mode*, switches from the copy mode to the facsimile mode. In other words, MATUSNAI does not teach that the threshold value for input of digits in the copy mode is related to how many digits the display screen is capable of displaying in the copy mode.

On the other hand, in the present invention, the threshold value for input of digits in the copy mode is related to how many digits the display screen is capable of displaying in the copy mode. For example, the specification of the present invention describes "For example, the threshold value for input digits is set at two to allow only two digits to be displayed", at page 7, lines 12-13.

Accordingly, MATSUNAI does not comply with the requirements of claims 35 and 44, as it does not disclose all of the features recited therein.

Therefore, it is respectfully submitted that as the features recited in Applicant's claims 35-36, 44 and 47-48 are not disclosed in MATSUNAI cited by the Examiner, these claims are patentable thereover.

With respect to claims 37-39 and 45, the Examiner contends that "from the time the system has determined a yes of STP 6, and before reaching STP 7 (select fax mode), the system is not responding to any keyboard entry to the system-including the start key". Applicant agrees with the Examiner that, when the system has determined a yes of STP 6, the facsimile mode is selected at STP 7.

However, this means that when the system has determined a yes of STP 6, the system does not maintain the copy mode, but rather selects the facsimile mode. Thus, MATSUNAI does not disclose a controller which, when the numerical value input by the panel section is not the numerical value corresponding to the number copies and when the start key is actuated, maintains the copy mode and inhibits copying.

Further, MATSUNAI does not disclose the controller which waits for another input by the panel section in the copy mode when the controller inhibits copying, since MATSUNAI immediately selects the facsimile mode at STP 7 when the system has determined a yes of STP 6.

In direct contrast, for example, the specification of the present invention discloses "On the other hand, since two, which is smaller than the number of digits in a facsimile transmission number, is used as the threshold value, if three or more digits are input and the start key 37 is entered during the copy mode, the execution of the mode is stopped to prevent copying and the display section 32 shows 'Enter correct number. Press reset key.' In this case, if a reset key 36 is entered, the operator starts all over again (S12)" at page 9, lines 13-20. Thus, the pending claims are completely distinguished over MATSUNAI.

Therefore, it is respectfully submitted that since the features recited in Applicant's claims 37-39 and 45 are not disclosed in MATSUNAI cited by the Examiner, the claims are patentable thereover.

With respect to claims 40, 42-43 and 46, the Examiner contends that "the specification does not disclose any of the number (0, 1, 2, ...9) would cause the system to switch from copy to fax mode", and "the term 'character' as defined by American

Heritage Dictionary of the English Language, is one set of symbols, such as letters or NUMBERS, that are arranged to express information”.

By the present amendment, Applicant has amended claims 40 and 46 to clarify the term “a predetermined character”. In particular, the claimed predetermined character does not include a numerical value. MATSUNAI does not contain any disclosure regarding a predetermined character, as claimed, that does not include a numerical value. Thus, MATSUNAI does not disclose a controller which, when the copy mode is set, determines whether or not an input by the panel section includes a predetermined character and which switches from the copy mode to the facsimile mode when the input by the panel section includes the predetermined character, the predetermined character not including a numerical value.

On the other hand, the present invention determines whether or not an input by the panel section includes a predetermined character when the copy mode is set, and switches from the copy mode to the facsimile mode when the input by the panel section includes the predetermined character, the predetermined character not including a numerical value. Thus, the pending claims are completely distinguished over MATSUNAI.

Therefore, it is respectfully submitted that since the features recited in Applicant's claims 40, 42-43 and 46 are not disclosed in MATSUNAI cited by the Examiner, the claims are clearly patentable thereover.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding objection and rejections, and an indication of the allowability of all the claims pending in the present application in due course.

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Newly submitted claims 47 and 48 define further features of Applicant's invention and are patentable over the MATSUNAI reference cited by the Examiner.



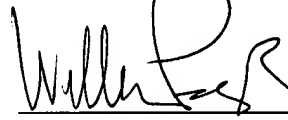
**SUMMARY AND CONCLUSION**

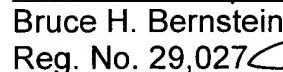
Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has amended the rejected claims for consideration by the Examiner. With respect to the pending claims, Applicant has pointed out the features thereof that distinguish the same from the cited reference. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course.

The amendments to the claims which has been made in this amendment, which has not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

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